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10/036,720	11/08/2001	Maren Christensen	13487-1	5730

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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07/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/036,720

Applicant(s)

CHRISTENSEN, MAREN

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24, 26, 28, 29, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-24, 26, 28-29, and 32-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1:121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is in response to the applicant's communication filed on May 14, 2007, wherein:

Claims 21-24, 26, 28-29 and 32-33 are currently pending;

Claims 21 and 28 have been amended.

Claims 25, 27, 31 and 34 have been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 14, 2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-24, 26, 28-29 and 32-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the disclosure provides nothing more than generalities, such as assessing and categorizing various intellectual properties. The applicant uses questionnaires posing questions pertaining to intellectual property and then packages the one or more contract documents with the one or more questionnaires. It is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data in order to take into account all of the subjective answers which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets. There is no indication in the specification of how the data is used to plan for all the potential uses of the properties and to maximize the use of the assets. For further examination the claims are interpreted in light of the 35 U.S.C. § 101, and 35 U.S.C. § 112, first paragraph rejection.

4. Claims 21-24, 26, 28-29 and 32-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention,

Applicant has added the limitations which were disclosed in claims 31 and 34 to independent claims 21 and 28 wherein the step of directing the review further comprises prompting selection of one or more special format answers, and wherein the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons.

Applicant's specification discloses:

[0155] As shown in FIG. 31, some questions ***may have special format answers***, for example requiring listing of territories or media. In such case, pull-down boxes listing possible choices, radio buttons, or similar programming techniques may be used to reduce error in entry and constrain the reviewer into a select group of choices. Additionally, optionally where answers are dependent and mutually exclusive, pull-down boxes and the like may be constrained to prevent inconsistent responses, or to allow branching to appropriate sub-parts. For example, as shown in FIG. 32, "yes" or "no" answers could be used to branch to avoid questions that would be irrelevant based upon the answer to the condition question.

Paragraph [0012] discloses:

a review module for directing review of the one or more than one contract document and acquisition of acquired responses to the one or more than one question posed in the one or more than one rights questionnaire

The Examiner is unable to find support for the limitation of ***wherein the step of directing the review further comprises prompting selection of one or more special format answers***. Furthermore, the Examiner does not find support for the limitation of ***wherein the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons***.

The Examiner has performed a search of the disclosure and submits that there is not sufficient disclosure for these newly added limitations, thus, these limitations are new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-24, 26, 28-29 and 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, applicant identifies the invention in the preamble of a method for managing intellectual property rights in an intellectual property arising from one or more than one contract documents. However, there is no managing step being performed in the body of the claims. The steps require a questionnaire to be prepared, packaging a document with legal questions, directing a review, acquiring responses, and storing the response.

Furthermore, after applicant prepares the questionnaire, applicant never incorporates the questionnaire into the language of the claims or links this step to the remaining steps. Thus, the step of preparing the questionnaire is never connected with the other steps.

The applicant claims a step of packaging the one or more contract documents and pertinent legal questions. However, the claims never identify what "pertinent legal questions" are or where they come from. It is assumed that they are related to the questionnaire. However, applicant's claim language fails to make this relationship.

The applicant claims a step of directing the review. Directing a review is not a positive recitation of a review being performed.

Applicant has a step of acquiring responses to the pertinent legal questions. However, it is not clear how this fits in with the other claim steps. Step 2 has the contract document and the legal questions packaged. Therefore, it is unclear at this time, why is there a step of acquiring response to pertinent legal questions. Is this supposed to be linked to the questionnaire? Is applicant trying to state that the questionnaire has one or more pertinent legal questions or are these questions separate and independent of the other pertinent legal questions?

Applicant has added in the step of wherein the step of directing the review further comprises prompting selection of one or more special format answers. It is not clear how this is linked to the rest of the claim or what this actually means.

Claim 21 is especially confusing in light of claim 28, wherein the preamble reads that the invention is a method of managing ownership rights in an intellectual property arising from one or more contract documents wherein there is a step of initializing a management program and creating data records and preparing a package having one or more rights questionnaires and the one or more than one contract documents. Is this packaging step the same as was defined in claim 21? If so, why is the package now containing one or more rights questionnaires rather than pertinent legal questions?

Furthermore, all applicant is claiming in claim 28 is accessing a network, initializing a program and creating records and preparing a package, routing the

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package for review, and receiving responses. How does this manage ownership of rights?

Furthermore, as in claim 21, applicant has attempted to link a clause stating that wherein the step of routing the package further comprises prompting a selection of one or more special format answers. How does a step of routing prompt a selection of special format answers?

It is not clear what the applicant means by the step of directing the review further comprises prompting selection of one or more special format answers. What does the applicant mean by this step? Is applicant trying to simply claim that answers to questions are prompted by multiple choice button, etc. If so, why not just claim prompting selection of one or more answers using special formats?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 21-24, 26, 28-29 and 32-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-24, 26, 28-29 and 32-33 do not produce a "concrete" result in the "method for managing intellectual property rights or the method for managing ownership rights in intellectual property rights". The steps in the present application do not produce concrete results. It is unclear how the present application expresses the use of the questionnaires and how they are used in maximizing the use of the intellectual

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property assets.

The results of applicant's invention in arriving at a probable success factor for maximizing the use of the intellectual property assets is clearly not the same results found in *State Street Bank & Trust Co. V. Signature Financial group, Inc.*, 149 F 3d 1371; 47 USPQ 2d 1599 decided by the U.S. Courts of Appeals. "Today we hold the transformation of data representing discrete dollar amounts by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula or calculation because it produces a useful, concrete and tangible result, a final share price momentarily fixed for recording and reporting purposes". In the State Street case the "concrete, tangible, and useful results" is allocating money to different funds.

In the *AT&T v. Excel Communications* the useful, concrete, and tangible results is the claimed step of "producing message record for long distance telephone calls, enhanced by addition of Primary Interexchange Carrier (PIC) indicator", the system performs different calculations and the result facilitates differential billing of calls made by the subscriber to long distance service carrier.

The definition of concrete is particular and specific, not general. In the present application, the disclosure is nothing more than generalities as to gathering, assessing and categorizing various intellectual properties. However, the disclosure is short on specifics as to explicitly how the contracts and the questionnaires are packaged or how the pertinent legal questions are generated or what criteria is used to link the data records or what determines how the hierarchical tree is generated which represents the

linkage between the data records and the pertinent legal questions. There appears to be many variables and subjective determination made at each step. Furthermore, it is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data in order to take into account all of these subjective factors which the process appears to entail. Although the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the data in maximizing the use of the assets.

Applicant discloses on page 20 of the specification that the packaging module will be operated by an individual who may be referred to as the packager to emphasize that the individual who operates the packaging module may be different from the person or persons who operate the remaining modules. Applicant states that a packager operates the packaging module, a reviewer operates the reviewing module and a searcher operates the search module. The applicant discloses that the packager and the searcher can be the same person and that the reviewer can be an attorney (page 20, lines 26-33). There appears to be considerable subjective determination in the invention. This is further evidenced by applicant's remarks submitted on May 14, 2007, wherein the applicant identifies the invention as:

The present invention, according to an embodiment, provides an intellectual property rights management method using a computer based interface to pose questions designed to elicit critical information about intellectual property rights, answered by those who have the best understanding of the rights acquired, to

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allow authorized individuals to determine the scope and extent of their holdings. The method comprises the steps of: packaging at least one contract document and pertinent legal questions pertaining to the intellectual property, directing the review of the at least one contract document and pertinent legal questions, acquiring responses to the pertinent legal questions, and storing the acquired responses in a database to permit searching of the acquired responses.

Therefore, it is clear from the definition of "concrete" and the analysis of the disclosure and the claimed limitations of the present invention mentioned above that the disclosure of the present invention is nothing more than generalizations regarding the various factors to be taken into consideration, and it is short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

NOTE: The Examiner finds that because claim(s) 21-24, 26, 28-29 and 32-33 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied as *much as practically possible*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 21-22, 26 and 33-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et. al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 21:

Rivette discloses method for managing intellectual property rights in an intellectual property arising from one or more than one contract document, comprising:
preparing one or more rights questionnaires having one or more questions (Figure 102 (10210))

packaging the one or more than one contract document and pertinent legal questions comprising one or more than one legal question pertaining to the intellectual property (Figure 102 (10210) See also Figure 1 (116), Figure 2 (214), Figures 68-70, figure 95 (9516), Figure 109, Figure 114, [0020] [0025] [0253-0254]);

directing the review of the one or more than one contract documents and acquisition of acquired responses to the pertinent legal questions (Figure 102 (10210), Figure 104-110), Figure 108 (10808-10810); and

storing the acquired responses in a database to permit searching the acquired responses (Figure 149(14918), [0402] [0277] [0305]).

Rivette does not disclose prompting selection of special format answers.

However, the Examiner asserts that it is old and well known to have questions to questionnaires answered by prompting with special formats such as multiple choice or radio button.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate to aid the user in providing the answer and to aid the party receiving the answer in analyzing and utilizing the information provided.

The Examiner asserts that the questions are designed to elicit information about ownership is non-functional descriptive data, not functionally related to the steps of the method. The Examiner asserts that nonfunctional descriptive material cannot render nonobvious an invention that otherwise would have been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 7- USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not function related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Referring to Claim 22 and 26:

Rivette discloses a method wherein the packaging step comprises the steps of:
initializing a management program and creating data records comprising one or more than one data records having information pertaining to the intellectual property (Figures 1-186);

generating the pertinent legal questions (102 (10210), Figure 105 (10508-10510));

linking the data records to the pertinent legal questions (Figure 95 (9516), Figure 105 (10506-10510), Figure 139 (13910);

displaying a hierarchical tree representing the linkage between the data records and the pertinent legal questions (Figures 18, 65, 71A, 72-73, 86 (8612) Figure 157); and

routing the one or more than one contract document, the pertinent legal questions and the data records to a reviewer (Figure 101 (10110)).

Referring to Claims 32-33:

Rivette does not disclose sending legal questions via email and receiving responses via email or that the email is encrypted and compressed.

However, sending information by email is an old and well known way of communicating. Furthermore, as admitted by applicant in paragraph [0141], these techniques are known in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the intellectual property analysis and management method of Rivette the ability to send and receive information via encrypted email since one skilled in the art at the time of the invention would have possessed this knowledge and skill and would utilize encrypted email as a way to provide quick, efficient and secure communication.

8. Claims 23-24 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette in view of Martin (US 6,330,547) (hereinafter referred to as Martin).

Referring to claims 23 and 24:

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66).

It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform an analysis.

Referring to Claim 28-29:

Rivette discloses method for managing ownership rights in an intellectual property arising from one or more contract documents [0897], comprising:

accessing a computer network (Figure 11);

initializing a management program and creating data records and preparing a package (Figures 3-12A)

routing the package for review (Figure 101 (10110)).

Rivette does not disclose wherein the generating step comprises offering choice of rights questionnaires or receiving response to the questionnaire.

However, Martin discloses questionnaires for gathering information pertaining to intellectual property assets (col. 5, lines 63-66). The Examiner asserts that it is old and well known to have questions to questionnaires answered by prompting with special formats such as multiple choice or radio button.

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It would have been obvious to one of ordinary skill in the art to incorporate into the patent information management method of Rivette the questionnaires taught in Martin so as guide the user to provide the complete data necessary to perform any analysis.

Response to Arguments

Applicant's arguments filed May 14, 2007 have been fully considered but they are not persuasive.

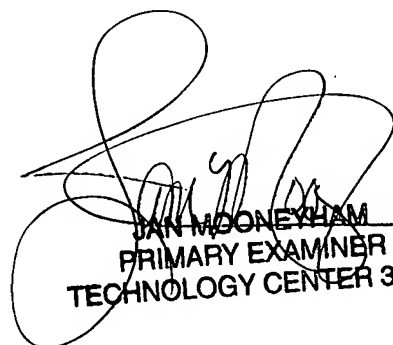
The Examiner has tried to address the applicant's arguments in the body of the rejections.

As for applicant's arguments against the motivation to combine Rivette and Martin, the applicant is directed to the two recent cases involving motivation to combine, KSR and Dystar.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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